

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

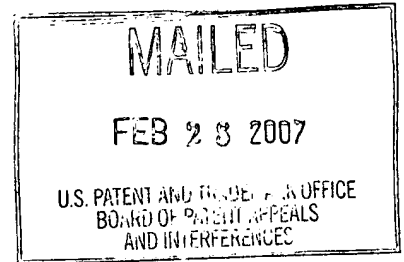
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte VIJAY KUMAR and YANG DONG

Appeal No. 2007-0744
Application No. 10/007,866

ON BRIEF



Before ADAMS, MILLS, and GRIMES, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 36.

Claim 36 is the only pending claim and appears in the attached appendix to the Brief.

Grounds of Rejection

Claim 36 stands rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement.

We affirm the written description rejection.

DISCUSSION

35 U.S.C. § 112, first paragraph

Claim 36 stands rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement.

The examiner contends that Appellants amended Claim 36¹ by incorporating into the claim the text "said biodegradable oxidized cellulose ester having an acid number of at least 133." Answer, page 3. The examiner argues that this amendment is not supported in the original specification.

Appellants point to Example 1, page 13, line 26, for support of this amendment to claim 36. Brief, page 5. This portion of the specification states the starting material for synthesis of the compound in the example has a carboxylic acid content of 13.7%. Appellants contend that Example 1 provides the acid content of the starting material and "the resulting compound has a carboxylic acid content of 10.57%, which directly converts to an acid number of 133.9. (8/25/05 amendment, p. 10)." Brief, page 5.

The examiner argues that the conversion of the acid number in Example 1 is insufficient documentation to support claim 36 because the instant specification does not disclose the carboxylic acid content of the resulting compound thereof and does not set forth the acid number of the resulting compound. We agree.

¹ Amendment filed August 25, 2005.

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Written description is a question of fact, judged from the perspective of one of ordinary skill in the art as of the relevant filing date. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1119 (Fed. Cir. 1991). In the present case, it has not been shown that one of ordinary skill in the art would have understood that the resulting compound of Example 1 would necessarily and inherently have the carboxylic acid content and acid number appellants attribute to it.

Appellants rely on Application of Nathan, 328 F.2d 1005, 1006, 140 USPQ 601, 604 (C.C.P.A. 1964), and Regents of the University of New Mexico v. Knight, 321 F.3d 1111, 1122, 66 USPQ2d 1001, 1009 (Fed. Cir. 2003), as authority supporting the amendment of the specification of an application with an inherent feature of a chemical compound described therein. Brief, pages 5-6; Reply Brief, page 3.

Appellants argue that carboxylic acid content of 10.57% and acid number of 133.9 are inherent in the resulting compound of Example 1, thus justifying amendment of the specification and claim 36 in this case as they did in Nathan and Knight. If such properties are as critical to the claimed invention as they appear to be, the written description of the specification must recite such physical and chemical properties.

We do not disagree that a specification can be amended to recite inherent properties of a chemical compound disclosed therein. Appellants are reminded, however, that arguments of counsel cannot take the place of evidence. In re DeBlauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984), In re Payne, 606 F.2d 303, 315, 203 USPQ 245, 256 (CCPA 1979). In the present case, Appellants

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have put forth no evidence to support their position that the resulting compound of example 1 necessarily, inherently has a carboxylic acid content of 10.57% and evidence that the carboxylic acid content of 10.57% directly converts to an acid number of 133.9. Such evidence may be made in the form of a Declaration under 37 C.F.R. §1.132.


In view of the absence of such evidence in the present case, the written description rejection is affirmed.

CONCLUSION

The rejection of claim 36 under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


Donald E. Adams
Administrative Patent Judge


Demetra J. Mills
Administrative Patent Judge


Eric Grimes
Administrative Patent Judge

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